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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MANOHARAN, VIRGINIA

ART UNIT PAPER NUMBER

1764

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,042

Applicant(s)

BLASCHKE, MARILYN WOOD

Examiner

Virginia Manoharan

Art Unit

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Handwritten signature/initials

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) 47-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 and 67-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (P
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Upon reconsideration, the restriction requirement dated 09/20/03, between Group I invention (claims 1-6, 7-10 and 11-14) and Group II invention (claims 15-46, & 67-78) has been withdrawn. However, because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement among Groups I, II and III, the election has been treated as an election without traverse (MPEP § 818.03 ()).

Claims 1-46 & 67-78 are the claims being examined.

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors, e.g., typographical, grammar, idiomatic, syntax and etc. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-46 and 67-78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) It is unclear what constitute "an amount and under condition effective to form a dispersion " and " .. under conditions of operation of said equipment" within the context of the claimed invention. See e.g., the independent claims.

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- (b) The numerously recited phrase "one or more" in the claims should be-at least one-to remove the alternative "or" . See e.g., claim 1.
- (c) The claimed "said fatty acid" in claims 3 and 23 lack proper antecedent basis for supports.
- (d) The numerously recited "about" e.g., "about 16 to about 22" in claim 3, "about 1 to about 6 carbon atoms in claim 4 and the terms "preferably" and "most preferably" such as "preferably from about 1 to 6 carbons ", in claim 7 and " most preferably from about 1 to 4 carbon atoms" in claim 7, all fail to ascertain the claimed invention with precision. [The specification does not exemplified values falling within the "about" ranges other than e.g., 1 & 6 carbons.
- (e). Claim 68 is in improper Markush grouping. [Those reviewing a claim from either a patentability or infringement viewpoint must be capable of knowing exactly what is covered by the claim in the Markush grouping. In the instant case, one simply doesn't know what is intended to be included with the recitation of "comprises".

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over anyone of Hollis et al abstract (S. African ZA 6805343), Ferm (4,410, 419) or Stanley (3,666,656).

Hollis et al discloses a process of adding a N,N-dimethylamide of straight chain carboxylic acid containing 18 atoms and having at least one C:C bond at concentration of 0.2-200 ppm for control of scale to affected surfaces of an aqueous system. See the abstract.

See also the Ferm's reference disclosing that the fouling of a heat exchanger is reduced when a hydrocarbon in 5 - 99 ppm of dialkyl fatty amide of the formula $\text{Me}(\text{CH}_2)_x(\text{CH}:\text{CH})_y$ is added to a stream passing through a heat exchanger so as to reduce fouling. In like manner, Stanley discloses basically similar method as above. Stanley discloses a process wherein as an anti-foulant, one component containing a hydrocarbon-substituted amide in the side chain is used. While not positively recited, obviously anyone of the above references, each treats a blend comprising the fouling agents as claimed. The prior art anti-foulants, being the same anti-foulants, as claimed, would obviously be covered by the general formula claimed in claims 7-8, & 11-12.

Claims 15-46 and 67-78 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- (a) Cooper et al discloses an antifoulant for acrylonitrile purification.
- (b) JP 01045407 abstract discloses using fouling inhibitors in a reactor.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Virginia Manoharan whose telephone number is (571) 272-1450. The examiner can normally be reached on Tuesday-Friday from 7:00a.m to 6:00p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola, can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9311.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Manoharan/tgd

March 15, 2004


VIRGINIA MANOHARAN
PRIMARY EXAMINER
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